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OFFICE OF PETITIONS

Mitchell R. Swartz, ScD, EE, MD
16 Pembroke Road
Weston MA 02493

In re Application of :
Mitchell R. Swartz :
Application No. 09/750,480 :
Filed: December 28, 2000 : **ON PETITION**
For: METHOD AND APPARATUS TO :
MONITOR LOADING USING VIBRATION :

This is a decision on the renewed petition under 37 CFR 1.181 filed November 1, 2010, to revive the above-identified application.

The petition is **DENIED**.¹

BACKGROUND

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of January 11, 2005. The reply to a final Office action must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

No reply was timely received in the above identified application and the application went abandoned on April 12, 2005. A Notice of Abandonment was mailed September 5, 2006.

A petition under 37 CFR 1.181 was filed September 13, 2006. It was treated as a petition to withdraw the holding of abandonment and was dismissed in a decision mailed October 19, 2010.

The instant renewed petition was filed November 1, 2010.

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

It is noted in this renewed petition, at paragraph 9, that petitioner states “Nowhere is there any mention of the fact that the purpose of the Petition was to remove abandonment like the erroneous, flawed ‘decision’ purports.” This statement is at odds with the petition filed September 13, 2006 which indicates in the first paragraph that the petition is filed with respect to the Office communication mailed September 5, 2006 which was a Notice of Abandonment. Since the petition was filed in regards to a Notice of Abandonment, the petitioner can only be considered as a request to withdraw the holding of abandonment under 37 CFR 1.181.

STATUTE AND REGULATION

§ 1.135 Abandonment for failure to reply within time period.

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

§ 1.113 Final rejection or action.

- (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.
- (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

- (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

MPEP 714.13(II) in part:

Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

- (A) an amendment complying with 37 CFR 1.116;
- (B) a Notice of Appeal (and appeal fee); or
- (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e).

OPINION

The petition decision mailed October 19, 2010, noted that applicant had failed to timely respond to the final Office action mailed January 11, 2005. Petitioner points out that a “response” was filed in the form of continuation ‘677 on April 6, 2005. A review of Office records shows that continuation application No. 11/099,677 was filed April 6, 2005 (a continuation of that application was filed as application No. 12/589,258 on October 20, 2009). Petitioner indicates that he never abandoned the application due to the filing of the continuation application.

It appears petitioner is confusing abandonment of an **application** with abandonment of an **invention**. When petitioner failed to file a proper response to the final Office action, he allowed the application to go abandoned. By timely filing a continuation application he was in effect not abandoning his invention. The filing of a continuation application has no effect on prosecution of the instant application. Therefore, the filing of a petition to withdraw the holding of abandonment in this application based on the fact that a continuation application was filed cannot be granted.

As petitioner has failed, despite repeated attempts, to provide any persuasive arguments meriting withdrawal of the holding of abandonment, the petition must be denied.

CONCLUSION

The prior decision, which refused to withdraw the holding of abandonment, has been reconsidered, and is affirmed.

Petitioner is not precluded from filing a petition to revive pursuant to 37 CFR 1.137. However, continued delay in filing such a petition, after this final agency action, may be determined to be intentional delay and may preclude revival of the application.

Finally, if petitioner wants a copy of the file history, it may be viewed by accessing Private PAIR. Instructions for setting up an account may be found at the following link:

http://www.uspto.gov/patents/process/status/private_pair/PrivPairOverview_Oct09.pdf

If you have any questions about setting up an account, you can contact the Electronic Business Center at 1-866-217-9197 or via email at EBC@uspto.gov.

Telephone inquiries related to this decision should be directed to Carl Friedman at 571-272-6842.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director, Office of Petitions